

REMARKS

This communication responds to the Final Office (*Office Action*) Action dated July 7, 2010. Claims 1, 22, and 24 are amended, no claims are presently canceled, and claims 26 and 27 are presently added. Claims 2 and 9-21 were previously canceled, and claims 13-21 are withdrawn. As a result, claims 1, 3-8, and 22-27 are pending and are currently being examined in this application.

Rejection of the Claims Under § 112

Claims 1, 3-8, 22-25

The Examiner rejected claims 1, 3-8, and 22-25 under 35 U.S.C. 112, first paragraph¹, as allegedly failing to comply with the written description requirement. The Examiner alleges that the claims "contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."²

In particular, the Examiner cited the claim element that "the second user is a member of a second population of users which are members of the virtual community and identified as investors." The language "which are members of the virtual community and" has been deleted in amended independent claims 1 and 22. Therefore, Applicants assert that claims 1 and 22 now comply with the written description requirement of 35 U.S.C. 112, first paragraph.

Claims 22-25

The Examiner rejected claims 22-25 under 35 U.S.C. 112, second paragraph³, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner has taken issue with

¹ *Office Action*, page 2, lines 6-7.

² *Id.* at page 2, lines 7-10.

³ *Id.*, page 2, lines 20-22.

claim language which recited that "the financial product is a newsletter."⁴ Amended claim 22 recites that "the financial *information* product is a newsletter" (emphasis added). Thus, Applicants assert that claim 22 is no longer indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 23-25, which depend from claim 22, are no longer indefinite for at least the same reasons as those cited above in relation to claim 22.

Rejection of the Claims Under § 103(a)

Claims 1, 3, 8, and 22-25

The Examiner rejected claims 1, 3, 8, and 22-25 under 35 U.S.C. 103(a)⁵ as allegedly being unpatentable over U.S. Patent No. 6,236,980 to *Reese* in view of U.S. Patent No. 6,408,309 to *Agarwal* and further in view of U.S. Patent No. 6,996,539 to *Wallman (Wallman I)*. Since a *prima facie* case of obviousness has not been properly established, Applicants respectfully traverse the rejection.

The U.S. Supreme Court decision of *KSR v. Teleflex* provided a tripartite test to evaluate obviousness.

The rationale to support a conclusion that a claim would have been obvious is that *all the claimed elements were known in the prior art* and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art.⁶

Applicants will show that the cited references, either singly or in combination, neither teach nor suggest all the limitations of Applicants' claimed elements, nor is there any substantiating evidence that any combination of the references would have yielded predictable results. "If any of these [three] findings cannot be made, then this rationale [of combining prior art elements

⁴*Id.*, page 3, lines 1-2,

⁵ *Id.*, page 3, lines 20-22.

⁶ See *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007); see also MPEP § 2143, emphasis added.

according to known methods to yield predictable results] cannot be used to support a conclusion that the claim would have been obvious."⁷

Although other rationales for rejection under 35 U.S.C. § 103(a) may exist, the basis for an obviousness rejection is still grounded in a consideration of all claim elements. "***All words in a claim must be considered*** in judging the patentability of that claim against the prior art."⁸ Additionally, to render the claimed subject matter obvious, the prior art references ***must*** teach or suggest every feature of the claims.⁹ Emphasis Added.

Applicants' amended independent claim 1 recites, in part, that

receiving, over a wide-area network, an indication of a preference of an investment or ***a weighted apportionment of assets for a set of investments*** from a device of a first user, the first user being a member of a first population of users, which are members of a virtual community identified as investment analysts; [and]

deriving, in response to the updated set of preferences, ***a position of a financial product*** for a second user, the second user is a member of a second population of users identified as investors, and the financial product is a mutual fund.

The Examiner cited to *Reese*, Fig. 5, as teaching "selecting, according to a first user, a preference of . . . ***a weighted apportionment of assets for a set of investments***." Fig. 5 of *Reese* presents article summaries and recommended reasons for investment action for a particular investment. The recommendation (corresponding to a preference) in *Reese* is a situation where a user selects a security and a published article of recommendation (bullish or bearish) on that specific security is displayed to the user. For instance, *Reese* discusses that

FIG. 5 illustrates the report that displays items of the recommendation capsules ***for the security selected by the user***.¹⁰

⁷ MPEP § 2143.

⁸ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); emphasis added. See also MPEP § 2143.03, emphasis added.

⁹ See Manual of Patent Examining Procedure §§ 706.02(j), 2143(A) (2008); MPEP § 2142 (2006) (citing *In re Vaeck*, 947 F.2d, 488 (Fed. Cir. 1991). Cited approvingly in *Ex parte WEN WEN* and *PATRICIA NG* at 7; Appeal No. 2009-000776; decided September 25, 2009.

¹⁰ *Reese*, column 8, lines 4-6.

In further reference to the invention and the recommendation, *Reese* states that

The invention utilizes a computer apparatus to automatically generate displays or reports containing security and element recommendations . . . from magazines, online sources, and broadcast programs *for one specific security or element at a time* or *one specific recommendation source at a time* selected by a user.¹¹

Clearly, the recommendation in *Reese* is directed to a specific security and not to *a weighted apportionment of assets for a set of investments* as recited in Applicants' amended claim 1. In fact, *Reese* is completely silent in regard to mentioning any distribution or apportionment of assets let alone *a weighted apportionment of assets*. Therefore, at least the claim element of *selecting a preference of a weighted apportionment of assets for a set of investments* is not known in the cited art of *Reese* nor do any of the disclosures of *Agarwal* or *Wallman*¹ cure this deficiency.

The Examiner also cited¹² to *Reese* as teaching "deriving *a position of a financial product* for a second user." *Reese* discusses a long list of objects and advantages of the invention including general questions about investing, a performance track record of sources, performance of certain securities, and finding advisors by monitoring their recommendations. For instance, *Reese* discusses that

[t]he invention can be used to answer the question: Can you still make money on a stock recommendation after it has appeared in a widely followed magazine or broadcast . . . The invention can reveal the performance track record of sources . . . you can see the performance of other securities in the articles . . . The invention can help a user find advisors with pleasurable rides and avoid those with painful rides.¹³

Reese discusses selecting and tracking securities and investment sources, including finding an advisor based on prior performance. But nowhere in *Reese* is there mention of *deriving a position of a financial product* as is recited in Applicants' amended independent claim 1.

¹¹ *Id.*, SUMMARY OF INVENTION.

¹² *Office Action*, page 4, line 6-9 (citing to col. 2, line 40 – col. 3, line 54 of *Reese*).

¹³ *Reese*, column 2, line 40 - column 3, line 8.

Therefore, at least this claim element is not known in *Reese* nor do any of the disclosures of *Agarwal* or *Wallman1* cure this deficiency.

Applicants have shown that not all the claimed elements were known as required by *KSR*, either by *Reese* singly or in combination with *Agarwal* or *Wallman1* with regard to Applicants' amended independent claim 1. Applicants' other independent claim, namely, claim 22, shares similar limitations with claim 1 and is therefore nonobvious for at least the same reasons as those cited above in relation to claim 1. Since Applicants' independent claims 1 and 22 are not obvious in light of the cited art, either singly or in combination, Applicants respectfully request the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103 with regard to each independent claim.

Further, since claims 3, 8, and 23-25 depend either directly or indirectly from claims 1 and 22, they too are allowable for at least the same reasons as the claims from which they depend. Further, each of the dependent claims may be allowable for its own limitations or features.

Rejection of Additional Dependent Claims under 35 U.S.C. § 103(a)

On page 6 of the *Office Action*, the Examiner rejected claims 4 and 5 under 35 U.S.C. § 103(a) as allegedly being obvious over *Reese* in view of *Agarwal* in view of *Wallman1* and further in view of U.S. Patent No. 6,049,783 to Segal et al (*Segal*). On page 7 of the *Office Action*, the Examiner rejected claim 6 under 35 U.S.C. § 103(a) as allegedly being obvious over *Reese* in view of *Agarwal* in view of *Wallman1* and further in view of U.S. Patent No. 6,473,084 to Phillips et al (*Phillips*). On page 8 of the *Office Action*, the Examiner rejected claim 7 under 35 U.S.C. § 103(a) as allegedly being obvious over *Reese* in view of *Agarwal* in view of *Wallman1* and further in view of U.S. Patent No. 6,338,047 to Wallman (*Wallman2*).

However, each of these claims depends, directly or indirectly, from claim 1 that Applicants assert is patentable. The cited references from each of: *Segal*, *Phillips*, or *Wallman2* singly fails to supply the elements of the independent claims that were shown above to be missing from *Reese*, *Agarwal*, or *Wallman1*. Therefore, a person having ordinary skill in the art,

having carefully considered *Reese*, *Agarwal*, *Wallman1*, *Segal*, *Phillips*, or *Wallman2*, whether alone or in any combination, would not conclude that the limitations of the independent claims are obvious as is required to support a *prime facie* case of obviousness in rejecting these claims of the present application under 35 U.S.C. § 103(a). Consequently, Applicants respectfully request that the rejection made under 35 U.S.C. § 103(a) with respect to these dependent claims be reconsidered and withdrawn. Moreover, each of these dependent claims may be patentable for its own limitations presented therein.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4054 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 7th day of September, 2010.

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